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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,223	08/01/2001	Paul Grudnitski	LLI001	8916
28848	7590	03/10/2004	EXAMINER	
TOPE-MCKAY & ASSOCIATES 23852 PACIFIC COAST HIGHWAY #311 MALIBU, CA 90265			SAADAT, CAMERON	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,223..

Applicant(s)

GRUDNITSKI ET AL.

Examiner

Cameron Saadat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-15, 17-31, 33-38 and 40-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15, 17-31, 33-38 and 40-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

In response to amendment filed 11/20/03, claims 1-8, 10-15, 17-31, 33-38, 40-46 are pending in this application. Claims 9, 16, 32, and 39 have been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 10, 17, 24, 25, 33, and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain the following subject matter:

“allowing a user to pull up a time indexed point in a video *corresponding to a point in a question*”

,which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 10, 17, 24, 25, 33, and 40 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “allowing a user to pull up a time indexed point in a video *corresponding to a point in a question*” is unclear.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8, 10-15, 17-31, 33-38, and 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortimer et al. (USPN 6,091,930; hereinafter Mortimer) in view of Papadopoulos (USPN 6,099,320).

Regarding claims 1, 2, 10, 17, 24, 25, 33, and 40, Mortimer discloses an interactive, case-based system for video-centric professional development of users, the interactive system comprising: a computer system including a processor for executing programs and a memory for storing programs, with the computer system having at least one display and at least one input element; the computer system further comprising: a media database for storing at least one time-indexed digital video case (Col. 5, lines 13-19; Col. 7, lines 20-26); at least one time-indexed text track with each text track corresponding to a digital video case, and with the time-indexes of the text track corresponding to time-indexes of the digital video case (Col. 9, lines 17-20); the media database further including a time-indexed table of contents for each digital video case (Col. 9, lines 19-34), digital resources relevant to each digital video case, and

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commentary relevant to each digital video case (Col. 9, lines 9-10); a video assignment database for storing at least one video case exercise and at least one video case user response (Col. 25, lines 15-35); a user database for storing personal user notes (Col. 18, lines 50-59); and a lesson database for storing lessons including a combination of items from the media database, the video assignment database, and the administration database that are organized to create a video-based lesson, and for storing groups of related lessons as courses; and a lesson building program for allowing a teacher-user to combine elements from the media database, the video assignment database, and the administration database to create a case-based video lesson therefrom and to store the lessons within the lesson database (see Fig. 3), the lesson building program further allowing the teacher-user to add elements to, to delete elements from, and to alter elements within the media database, the video assignment database, and the administration database (col. 7, lines 8-9); the lesson building program further allowing the teacher-user to organize lessons and exercises to create courses, each including a plurality of lessons; and a lesson viewer program for allowing a user to view and navigate through the courses and lessons to select a lesson to perform, to navigate through and view the elements of the lesson to perform (see Fig. 6d), and to provide input into the video assignments in the form of responses to exercises and to view, create, and edit entries into a notebook of personal user notes (Col. 18, lines 50-59).

Mortimer further discloses lesson exercises including requests for user input in the form of questions (Col. 25, lines 45-50) and time-indexed video case answers and marking codes (Col. 22, line 67- Col. 23, line 4), wherein the lesson exercises may be configured to allow time-indexed video case user responses to be viewable by a plurality of users and to be applicable to only one lesson or to a plurality of lessons, and wherein lesson exercises can optionally accommodate the use of file attachments to allow for uploading time-indexed video case answers from the client systems to the server system (Col. 11, line 62 – Col. 12, line 8).

Mortimer discloses all of the claimed subject matter of claims 1, 2, 10, 17, 24, 25, 33, and 40 with the exception of not explicitly disclosing that the administrative database comprises user access permission information. However, Papadopoulos teaches a video-based instructional system wherein an administrative database comprises user access permission information (Col. 4, lines 38-40). Hence, in view of Papadopoulos, it would have been obvious to an artisan to modify the administrative system described in Mortimer, by providing an administrative database comprising user access permission information in order to identify a level of access of a user as a student, author, or administrator and thereby present authoring, training or administrative materials to the identified user.

Regarding claims 3, 11, 18, 26, 34, and 41, Mortimer discloses a server system further includes a web server system for serving lessons to the client computers (Col. 24, line 45).

Regarding claim 4, 12, 19, 27, 35, and 42, Mortimer discloses digital video cases that are stored locally on the client systems (See Fig. 1, ref. 14).

Regarding claim 5, 13, 20, 28, 36, and 43, Mortimer discloses digital video cases that are provided on a storage medium selected from the group consisting of hard disks, optical disks, magnetic disks, and magnetic tapes (Col. 5, lines 30-31).

Regarding claims 6, 14, 21, 29, 37, and 44, Mortimer discloses digital video cases that are downloaded from a server system onto the client systems so that they may be played back locally during lessons (Col. 24, lines 55-57).

Regarding claim 7, 15, 22, 30, and 45, Mortimer discloses a server system further comprising a video and index builder for building a time-coded text track, a time-coded index, and a time-coded table of contents for a time-coded digital video case. (Col. 9, lines 17-20; Col. 9, lines 19-34; Col. 18, lines 50-59).

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Regarding claim 8, 23, 31, 38, and 46, Mortimer further discloses means for uploading digital video cases, time-coded text tracks, time-coded indexes, and time-coded tables of contents from the client computers to the server computer for use by an author in creating a lesson (Col. 18, lines 50-59).

Response to Arguments

Applicant's arguments with respect to claims 1-8, 10-15, 17-31, 33-38, 40-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Moehrle (USPN 6,599,130) – discloses a video educational session wherein users may insert time-indexed comments.

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- Ho et al. (USPN 6,336,029) – disclose an educational system wherein a user is prompted to ask questions, and wherein a time-stamp indicates when the user asked a question.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS


Teresa Walberg
Supervisory Patent Examiner
Group 3700